

30 MAR 1999



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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In re Application of: LAUK
U. S. Application No.: 08/981,924
PCT Application No.: PCT/DE96/01269
Int. Filing Date: 12 July 1996
Priority Date: 12 July 1995
For: METHOD FOR DETERMINING THE
EFFECTIVENESS AND TOLERANCE OF
A XENOGENEIC SUBSTANCE
ADMINISTERED TO AN ORGANISM

DECISION ON
PETITION
UNDER 37 CFR 1.137(a)

This is in response to applicant's PETITION TO REVIVE UNAVOIDABLY ABANDONED APPLICATION (IN ACCORDANCE WITH MPEP 711.03(c)) received 22 October 1998 that seeks revival of the application on the grounds of unavoidable delay.

The petition is DISMISSED, without prejudice.

BACKGROUND

On 12 July 1996, applicant filed international application PCT/DE96/01269 claiming priority to an earlier German application filed 12 July 1995. A copy of the international application was timely communicated to the United States Patent and Trademark Office from the International Bureau. A DEMAND for international preliminary examination, in which the United States was elected, was filed on 05 February 1997. Accordingly, the thirty month period for paying the basic national fee in the United States of America expired at midnight on 12 January 1998.

On 13 January 1998, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States under 35 U.S.C. 371, accompanied by, inter alia, the requisite basic national fee, a declaration of the inventor and an English translation of the international application.

On 06 April 1998, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) to inform the applicant, that all the requirements

of 37 CFR 1.495 had been satisfied and that the application was accepted for entry into the national stage in the United States as of 13 January 1998.

On 06 October 1998, a communication was mailed to the applicant, informing that the full basic national fee was not paid by the expiration of the statutory thirty month deadline from the priority date claimed of 12 July 1995. Accordingly, applicant has not met the requirements under 35 U.S.C. 371 and the Notification of Acceptance of Application of 06 April 1998 was issued in error.

On 22 October 1998, the United States Patent and Trademark Office (PTO) received from applicant the instant petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, accompanied by, *inter alia*, the requisite small entity petition fee, a second or subsequent transmittal letter to the United States designated/elected office (DO/EO/US) concerning a filing under 35 U.S.C. 371, the requisite surcharge for furnishing the oath or declaration and processing fee for furnishing the English translation later than thirty months from the earliest priority date. The petition fee of \$55, the surcharge of \$65 and the processing fee of \$130 has bee charged to Deposit Account No. 50-0355, as authorized in the transmittal letter.

DISCUSSION

37 CFR § 1.137(a), Revival of abandoned application or lapsed patent, in part, states:

Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing proposed response to continue prosecution of that application.

- (2) the petition fee as set forth in § 1.17(1);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (c) of this section.

Applicant has satisfied items (1) and (2) and, as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

As to item (3), applicant's petition states that:

... the subject request for nationalization of the above mentioned PCT application was deposited as air mail outside the United States via Federal Express Carrier International Services mail . . . on January 8, 1998 from Stuttgart/Germany by Heike Freudemann of Schuster and Partner, . . . The normal time of delivery for such mail is two days. Despite due care, the subject communication was not timely filed in the United States Patent and Trademark Office, . . ."

Applicant has not presented any evidence of the date and time the papers were delivered to Federal Express such as a copy of the mailing label. Nor has applicant presented any evidence from Federal Express as to how long it should take to deliver a package from Germany to the United States Patent Office (USPTO) taking into consideration that a weekend was involved between the alleged time of deposit and the receipt in the USPTO.

Applicant's petition is **DISMISSED** without prejudice.

CONCLUSION

The above facts raise a question of **ABANDONMENT** for failure to provide the basic national fee by the 30 month deadline of 12 January 1998.

Applicant is hereby afforded **TWO (2) MONTHS** from the mailing date of this decision to submit appropriate evidence in accordance with 37 CFR 1.137(a) or to request other appropriate relief, e.g. a petition to revive under 37 CFR 1.137(b).

Extensions of time may be obtained under 37 CFR 1.136(a).

The application papers will be retained in the PCT Legal Office pending response to this Decision. Failure to timely file a response to this Decision will result in a holding of ABANDONMENT of this application.

Any further correspondence with respect to his matter should be addressed to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, with contents of the letter marked to the attention of the PCT Legal Office.



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